

## Remarks

Applicants respectfully request reconsideration of the present U.S. Patent application as amended herein. Claims 1, 14, 17, 22 and 28 have been amended. Claim 2 has been canceled. Claims 29-36 have been added. Thus, claims 1 and 3-36 are pending.

### Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 1 and 3-28 were rejected as failing to comply with the enablement requirement. The Office Action states:

The specification does not describe a "subset of electronic documents" nor does it describe means for carrying out the functions of acquiring or creating a subset of documents. The specification also does not describe distinguishing the "subset of documents" to be published from the documents not included in the subset that are not to be published.

See page 2, comment 2.

The independent claims have been amended to remove references to a "subset of electronic documents." The independent claims have been amended to recite transforming selected electronic documents to meet standards for publication as described, for example, at page 9, lines 18-21. Therefore, the claims are enabled as required by 35 U.S.C. § 112, First Paragraph. Accordingly, Applicants request that rejection of claims 1 and 3-28 under 35 U.S.C. § 112, First Paragraph be withdrawn.

### Claim Rejections - 35 U.S.C. § 103(a)

Claims 1, 3, 4, 8-17, 22, 27 and 28 were rejected as being unpatentable over U.S. Patent No. 5,848,413 issued to Wolff, et al. (*Wolff*) in view of U.S. Patent No. 5,978,477 issued to Hull, et al. (*Hull*) and further in view of Bauer, et al. (*Bauer*).

Claim 1 recites:

a multifunction machine to supply multiple electronic documents that have been saved in the absence of an explicit command by a user to save the electronic documents and in response to another user specified function associated with the electronic documents;

a filter coupled with the multifunction machine to *transform one or more of the electronic documents to meet predetermined content-based standards for publication over a network if the one or more electronic documents do not meet the standards for publication;*  
and

a server coupled to the filter, the server having memory to store the electronic documents, the server to publish the subset of electronic documents by selectively permitting access to the subset of electronic documents.

Thus, Applicants claim a filter that transforms electronic documents to be published if the electronic documents do not meet predetermined content-based standards for publication.

Claim 14 is drawn to a method and also recites content-based transformation. Claim 17 is drawn to a computer-implemented method and also recites content-based transformation. Claim 22 is a means-plus-function claim that recites content-based transformation. Claim 28 is drawn to an article of manufacture and also recites content-based transformation.

The section of *Wolff* cited in the Office Action discloses a gateway that receives a fax document and transforms the fax document to a hypertext document. See col. 7, lines 29-20 and 40-44. The documents are stored and identifiers are provided. See col. 7, lines 58-60. However, *Wolff* does not teach or suggest content-based transformation. *Hull* is cited to teach storing documents without user intervention. See col. 6, lines 49-51. Thus, *Hull* discloses archival of documents. However, *Hull* does not disclose content-based

transformation. Therefore, no combination of *Wolff* and *Hull* discloses content-based transformation as claimed in claims 1, 14, 17 and 22.

*Bauer* is cited to teach maintaining access logs on a server that provides access to electronic documents. Whether or not *Bauer* discloses access logs, nothing in *Bauer* teaches or suggests content-based transformation as discussed above. Therefore, *Bauer* does not cure the deficiencies of *Wolff* and *Hull*. Thus, no combination of *Wolff*, *Hull* and *Bauer* can teach or suggest the invention as claimed in claims 1, 14, 17 and 22.

Claims 3, 4, 8-14, 29 and 30 depend from claim 1. Claims 15, 16, 31 and 32 depend from claim 14. Claims 33 and 34 depend from claim 17. Claim 27 depends from claim 22. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 3, 4, 8-13, 15, 16, 22 and 29-34 are not rendered obvious by *Wolff*, *Hull* and *Bauer* for at least the reasons set forth above.

Claims 5-7, 19-21 and 24-26 were rejected as being unpatentable over *Wolff* in view of *Hull* and further in view of U.S. Patent No. 6,317,777 issued to Skarbo, et al. (*Skarbo*). *Skarbo* is cited to teach auto-deletion of an electronic document. Whether or not *Skarbo* discloses auto-deletion, *Skarbo* does not cure the deficiencies of *Wolff* and *Hull* as described above. Therefore, no combination of *Wolff*, *Hull* and *Skarbo* teaches or suggests the invention as claimed in claims 5-7, 19-21 and 24-26.

### Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1 and 3-28 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by

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Examiner Flynn, Kimberly D.  
TC/A.U. 2153

telephone if such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number  
02-2666.


Respectfully submitted,  
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